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In re Application of :
Marc Alizon et al :
Serial No.: 08/308,219 : SUSPENSION OF ACTION
Filed: September 19, 1994 :
Attorney Docket No.: 3495.0010-20 :

This is in reply to the petition under 37 CFR 1.103 to suspend action on this application at applicant's request for a period of six months, filed November 28, 2005.

A review of the file history shows that applicants replied to the non-Final Office action mailed April 25, 2005, on October 25, 2005, including a request and fee for a three month extension of time. Applicants request that action on this application be suspended for six months in order to determine the correct assignees so that a terminal disclaimer can be filed..

§ 1.103 Suspension of action by the Office.

(a) Suspension for cause . On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:

- (1) A showing of good and sufficient cause for suspension of action; and
- (2) The fee set forth in § 1.17(h), unless such cause is the fault of the Office.

Applicants' petition states that they are making an effort to determine the correct ownership of the instant application and of US 6,627,395 in order for a proper terminal disclaimer to be filed. Applicants note that the application and patent must be commonly owned in order for a terminal disclaimer to be proper. Applicants also indicate that the correct inventorship must be determined. Applicants have submitted a complete reply to the last Office action.

It is noted that the rule permits suspension of action for "good and sufficient cause" as evidenced by a showing. Although the application is under rejection for obvious double patenting, which may be overcome by filing of a terminal disclaimer, applicants have not filed such disclaimer to date. Currently the application is under assignment to two different assignees. In order for a terminal disclaimer to be filed the instant application and the application or patent over which the rejection has been made must be commonly owned or assigned. This appears to not be the situation here. Applicants have indicated that Institut Pasteur is under the obligation of determining the correct assignees and preparing the appropriate legal documents and that this is

difficult as the earliest claimed priority date in both application and patent is over 20 years ago. No showing as to what effort is being to resolve the problem made has been given, thus no sufficient showing has been made. Further, one of the requirements of a terminal disclaimer is that the inventions in the affected applications must have been commonly owned or subject to common assignment at the time the respective inventions were made, not just commonly owned at the present time (although this is also a requirement). A review of the inventorship of the application and patent over which the rejection has been made shows no inventors in common. Thus the inventorship at the time of filing is presumed to be correct in each application; otherwise it should have been corrected at an earlier date.

Further, due to the inordinately long prosecution (over ten years) of this application, as well as the claim of priority extending back more than 10 years earlier than the filing date, suspension of action would not be appropriate. The Office is under obligation to bring prosecution to conclusion as soon as possible.

In view of the above reasons the petition is **DENIED**.

Any renewed petition must be submitted within TWO MONTHS of the mail date of this decision in order to be considered timely.

The examiner has recently mailed (December 5, 2005) a Final Office action to applicants. Applicants, in view of the above decision, remain under obligation to reply thereto within the time period set therein or as extended under 37 CFR 1.136(a).

Should there be any questions with respect to this action, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, P. O. BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission at the Office general facsimile number, 571-273-8300.

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